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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/784,980

02/16/2001

Anthony John Bell

5641C1-07-LAV

5253

7590 03/25/2009  
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EXAMINER

CHAWLA, JYOTI

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/25/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/784,980	<b>Applicant(s)</b> BELL ET AL.	
	<b>Examiner</b> JYOTI CHAWLA	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 and 46-55 is/are pending in the application.  
     4a) Of the above claim(s) 10-27 and 46-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 28-36 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2009 has been entered. Claims 1-36 and 46-55 are pending in the application. Claims 10-27 and 46-54 were withdrawn from further consideration as being directed to a non-elected invention. Claims 1, 2, 4-5, 8, 28, 31-32 and 55 have been amended. Claims 1-9, 28-36 and 55 are examined in the present office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-9, 28-36 and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 28 and 55 recite the limitation "unpleasant mouth feel", which is indeterminate as it is a subjective description that may vary from one person to another, thus rendering the claims indefinite. For example, a food or flavor that might have unpleasant mouthfeel for some, may be desirable for others. For the same reason, the recitation "being effective" to "suppress said unpleasant mouthfeel" of said botanical is also indefinite given that what may be "effective" suppression for one individual may not be sufficiently effective suppression for another person.

Further, claim 1 recites "an amount of from about 0.5% to about 5.0% by weight of said composition of an unpleasant mouthfeel suppressing agent consisting essentially of one

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or more partially hydrogenated vegetable oils or saturated fats” (emphasis added).

From the above recitation, it appears that "said composition" refers to composition of "an unpleasant mouthfeel suppressing agent" which is part of the candy composition. However, line 1 of claim 1 recites "candy composition", and hence "said composition" (emphasis added) may also refer to the candy composition as a whole. As such, it is not clear what "said composition" refers to. Claims 28 and 55 recite similar limitations. For the purposes of this office action, it will be assumed that "said composition" refers to the candy composition as a whole.

For the purposes of expediting the prosecution any confection with a botanical and having the claimed range of partially hydrogenated vegetable oils or saturated fats would be considered relevant prior art.

Claim 4 recites "partially hydrogenated vegetable oil may be is selected from the group consisting of cottonseed, soybean, peanut, palm, sunflower seed and corn oil and combinations thereof, and the saturated fat is selected from the group consisting of palm kernel oil, coconut oil cocoa butter, and butter, and combinations thereof" (emphasis added), which appears to indicated that both partially hydrogenated vegetable oils and saturated fats may be required. However, claim 4 depends from claim 1 which recites that unpleasant mouthfeel suppressing agent consists essentially of one or more "partially hydrogenated vegetable oils or saturated fats" (emphasis added). Thus, claim 4 (and claim 31 which recites similar limitations) contradict claim 1, from which they depends. For the purposes of this office action, it will be assumed that the recitation of claims 4 and 31 require hydrogenated vegetable oil or saturated fat, which is consistent with claim 1.

Claims 6, 7, 33 and 34 recite that the saturated fat or partially hydrogenated vegetable oil maybe present "at 0.5% to 3.5%", but do not define how the percentages are calculated (for example, by weight or by volume of the entire composition or part of the composition). As such, the recited percentages are indeterminate.

***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-9, 28, 31-36 and 55 are rejected under 35 U.S.C. 102(b) as anticipated Carpenter et al (US 5637344)

OR

Claims 1, 4-9, 28, 31-36 and 55 are rejected under 35 U.S.C. 103(a) as unpatentable over Carpenter et al (US 5637344), hereinafter Carpenter, in view of Seang et al (WO 94/05260), hereinafter Seang.

Regarding claims 1 and 55, Carpenter teaches a hard boiled candy composition comprising (or consists essentially of):

(a) a confectionery base comprised of a mixture of at least one sugar (column 6, lines 20-28) and at least one carbohydrate bulking agent (Column 6, lines 33-35) which is kept in an amorphous or glassy condition (Column 2, lines 55-61);

(b) at least one botanical (e.g., cocoa powder, see Column 2, lines 65-67) having an unpleasant mouthfeel; and,

(c) an amount of from about 0.5% to about 5.0% by weight (Column 9, lines 1-6) of said composition of an unpleasant mouthfeel suppressing agent consisting essentially of one or more partially hydrogenated vegetable oils or saturated fats (Column 6, lines 58-67 and Column 7, lines 1-7), said amount being effective to suppress said unpleasant mouthfeel of said botanical.

It is noted that the recitation wherein the agent is “an unpleasant mouthfeel suppressing agent” and said amount “being effective to suppress said unpleasant mouthfeel” of said botanical are a recitation of the intended use of the claimed invention must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case given that the amount of hydrogenated vegetable oils or saturated fats taught by Carpenter falls in the recited range (Column 6, lines 58-67 and Column 7, lines 1-7), it follows that the prior art (i.e., Carpenter as described above) structure is capable of performing the intended use.

Regarding claim 28, Carpenter teaches the claimed method and all limitations of the claimed method have already been addressed in claim 1.

OR

Alternatively, regarding claims 1, 55 and 28 Carpenter teaches a hard boiled candy composition comprising (or consists essentially of):

(a) a confectionery base comprised of a mixture of at least one sugar (column 6, lines 20-28) and at least one carbohydrate bulking agent (Column 6, lines 33-35) which is kept in an amorphous or glassy condition (Column 2, lines 55-61);

(b) at least one botanical (e.g., cocoa powder, see Column 2, lines 65-67) having an unpleasant mouthfeel; and,

(c) an amount of from about 0.5% to about 5.0% by weight (Column 9, lines 1-6) of said composition of an unpleasant mouthfeel suppressing agent consisting essentially of one or more partially hydrogenated vegetable oils or saturated fats (Column 6, lines 58-67 and Column 7, lines 1-7), said amount being effective to suppress said unpleasant mouthfeel of said botanical.

Regarding the limitation of partially hydrogenated vegetable oils or saturated fats as unpleasant mouthfeel suppressing agent, Seang teaches that lipids (oils and fats) were known for masking the bitter taste (i.e., unpleasant mouthfeel) (Page 1, line 28, Page 4, lines 6-15, 35-37; Page 5, lines 5-7; Page 6, lines 5-15). Thus, effect of lipids in masking

the unpleasant mouthfeel was known at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention that the partially hydrogenated vegetable oils or saturated fats in applicants' recited range, as taught by Carpenter will suppress the unpleasant mouthfeel of botanical in a similar manner as the partially hydrogenated vegetable oils or saturated fats in the instantly claimed invention.

Regarding claims 4, 5, 31 and 32, Carpenter teaches that the saturated fat may be cocoa butter or butter (Column 6, line 67 to Column 7, line 2) as claimed.

Regarding claims 6, 7, 33 and 34, Carpenter teaches that the saturated fat or partially hydrogenated vegetable oil may be present at greater than about 3% and less than 5% (Column 9, lines 1-6), which falls in the recited ranges of 0.5% to 3.5% (for claims 6 and 33) or 0.75% to 3.0% (for claim 7 and 34).

Regarding claims 8, 9, 35 and 36, Carpenter teaches that the ratio of the saturated fat or partially hydrogenated vegetable oil to the botanical is from about 1:100 to 3:1 (Col. 7, lines 40-45), which includes ratio values that falls in the recited range of ratios of 1/1 to about 1/0.01 (for claims 8 and 35) and from 1.0/0.6 to 1.0/0.15 (for claims 9 and 36).

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not

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commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-3 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter (US 5637344) in view of Raymont (AU-A-71904/96)

OR

Claims 2-3 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter in view of Seang, further in view of Raymont (AU-A-71904/96)

Carpenter has been applied to reject claims 1,4-9, 28, 31-36 and 55 above

OR

Carpenter in view of Seang has been applied to reject claims 1,4-9, 28, 31-36 and 55 above.

Regarding claims 2, 3, 29 and 30, Carpenter teaches substantially the claimed candy composition but does not teach that the botanical is selected from the group consisting of "Echinacea, Siberian Ginseng, Ginko Biloba, Kola Nut, Goldenseal, Golo Kola, Schizandra, Elderberry, St. Johns Wort, Valerian and Ephedra, and combinations thereof". Raymont teaches a lozenge composition (page 3, lines 30-31), which are similar to hard candy compositions, which comprises at least one botanical, wherein the botanical may be Echinacea. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Carpenter such that the botanical may be Echinacea. One of ordinary skill would have been motivated to modify Carpenter at least for the purpose of deriving known benefits of Echinacea such as stimulation of immune system (see Raymont, page 5, lines 20-25).



### ***Response to Arguments***

Applicant's arguments submitted 1/12/09 regarding the rejection have been fully considered but are moot in view of new grounds of rejection.

Applicant's argument regarding the term "unpleasant mouthfeel" on pages 13-15 of applicant's response is still relevant. Applicant argues that the term "unpleasant mouthfeel" is not indefinite as the term may be defined based on "focus groups" to ascertain public's reaction to mouthfeel (Remarks, page 14, lines 7-11). Whereas it is true that "focus groups" may be used for approximate qualitative assessment of parameters like mouthfeel for specific target customer groups, the term "unpleasant mouthfeel" by itself (without other qualifiers) does not enable one of ordinary skill in the art to definitively establish what is included and what is excluded, thus making the metes and bounds of the claim unclear. Further, applicant's disclosure is not enabling with respect to showing that the "unpleasant mouthfeel" of any and every botanical (that may be supposedly deemed to have "unpleasant mouthfeel" by a "focus group") is suppressed by the claimed "suppressing agent".

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/  
Examiner  
Art Unit 1794

/JENNIFER MCNEIL/  
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